

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

62063.US (EI-7621)

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/752,805

Filed

1-7-2004

First Named Inventor

Nubar OZBALIK et al.

Art Unit

3371

Examiner

Lang, Amy T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 44,990  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



Signature

Leah O. Robinson

Typed or printed name

(865) 546-4305

Telephone number

June 14, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Application No.: 10/752,805**  
**Atty Docket No. : 62063.US**  
**Client Docket No.: EI-7621**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>In re Application of</b>	Nubar OZBALIK, et al.	<b>Examiner:</b>	Lang, Amy T.
<b>Application No.:</b>	10/752,805	<b>Art Unit:</b>	3371
<b>Date Filed:</b>	January 7, 2004	<b>Confirmation No.:</b>	5115
<b>Title:</b>	POWER TRANSMISSION FLUIDS WITH ENHANCED ANTI-SHudder CHARACTERISTICS		

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O Box 1450  
Alexandria VA 22313-1450

Sir:

In response to the final office action dated March 14, 2007, and Advisory Action mailed June 7, 2007, Applicants hereby respectfully request consideration of the arguments presented in this Pre-Appeal request and request favorable action in response thereto.

This response is believed to be timely filed, as it is being filed within three months of the mailing date of the Final Office Action.

**REMARKS**

The invention, as defined by the currently pending independent claims, relates to a power transmission fluid and a power transmission additive composition that includes, *inter alia*, a friction improving amount of a polyisoalkylene component having a molecular weight ranging from about 300 to about 10,000 weight average molecular weight as determined by gel permeation chromatography, wherein the power transmission fluid exhibits a kinematic viscosity (KV at 100°C) of less than about 9 centistokes and a Brookfield viscosity (BV at -40°C) of less than about 30,000 centipoise, and wherein a friction versus velocity curve for the fluid has a more positive slope at high speeds compared to similar fluids in the absence of the polyisoalkylene component, and wherein the fluid has a friction drop at high speeds of less than about 0.008.

In the final office action and the Advisory Action, it was manifest error for the examiner to fail to consider all of the elements of the claims as written. None of the prior art of record discloses a power transmission fluid or power transmission additive composition wherein a friction versus velocity curve for the fluid has a more positive slope at high speeds compared to similar fluids in the absence of the polyisoalkylene component. In the Advisory Action, the examiner states that the phrase “power transmission fluid” is an intended use phrase and therefore not given patentable weight. However, according to MPEP 2111.02 II, “a preamble may provide context for claim construction, particularly where that preamble’s statement of intended use forms a basis for distinguishing the prior art in the patent’s prosecution history.” *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004). Also, “Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.” *Catalina Mktg. Int’l v. Coolsavings.com, Inc.*, 289 F.3d at 808-09, 62 USPQ2d at 1785. Applicant’s responses of record, especially page 13 of the response submitted on May 14, 2007 and page 11 of the response submitted on December 8, 2006, clearly rely on the limitation of a “power transmission fluid” to distinguish the claimed invention from the prior art of record, and therefore such limitation should be given

patentable weight and full consideration. Accordingly, the prior art of record fails to teach, suggest, or disclose all of the limitations of the present claims, and an anticipation rejection can not properly be made.

Further, the examiner's position that a fuel composition can be substituted for a lubricant composition is erroneous and incorrect, as explained on page 18 of the response submitted on May 14, 2007 and page 13 of the response submitted on December 8, 2006.

Hence, it is improper for the examiner to have made the suggested combinations in the obviousness rejections, because there is no motivation to combine the primary reference, directed toward a two-cycle engine fuel oil composition with any of the other references, directed toward other lubricant compositions, since a two-cycle engine oil is manifestly different in function and composition from other lubricants, as explained on page 17 of the response submitted on May 14, 2007.

It is therefore respectfully requested that the rejections be withdrawn, and the claims be allowed.

Fees

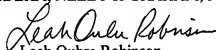
In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Conclusion

It is therefore respectfully requested that the rejections be withdrawn and the claims be allowed.

Respectfully submitted,  
LUEDEKA, NEELY & GRAHAM, P.C.

By:

  
Leah Oubre Robinson  
Reg. No. 44, 990

June 14, 2007  
P.O. Box 1871  
Knoxville, TN 37901  
865.546.4305 (tel)  
865.523.4478 (fax)  
LRobinson@lng-patent.com